

REMARKS

In accordance with the foregoing, claims 1-3 and 5-21 are amended and new claim 23 is presented. Claim 22 is cancelled without prejudice or disclaimer. No new matter has been added and accordingly, entry and approval are respectfully requested.

Claims 1-21 and 23 are pending and under consideration. Reconsideration is requested.

Claim Amendments

Independent claim 1 is amended herein to recite a device for reading electronic mails including "a storing unit storing unread/already-read information corresponding to each of received electronic mails; a controller indicating a change of the unread/already-read information corresponding to an unread electronic mail in the case where a body of the unread mail is displayed in response to a first command and not indicating the change of the unread/already-read information corresponding to the unread electronic mail in the case where a body of the unread mail is displayed in response to a second command; and a managing module changing the unread/already-read information of the storing unit based on the indicating of the controller." Independent claims 8 and 15 are similarly amended.

Support for the amendments is found for example, in Fig. 1 and page 8, line 21 - page 11, line 19 of the specification. No new matter has been added and accordingly, entry and approval are respectfully requested.

Pages 2-4: Rejection of claims 1, 8, and 15 under 35 U.S.C. §112, first paragraph

On pages 2-4 of the Office Action, the Examiner rejects claims 1, 8, and 15 under 35 U.S.C. §112, first paragraph and asserts that the phrase "wherein the list of electronic mail in the created unread mail list is unchanged until a later second time even if an already-read condition of an electronic mail in the created unread mail list is fulfilled before the later second time" contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (See, Action at page 3).

Claims 1, 8, and 15 are amended herein to address the Examiner's concern. Applicant submits that claims 1, 8, and 15 comply with 35 U.S.C. §112, first paragraph and requests withdrawal of the rejection.

Pages 6-11: Rejection of claims 1-6, 8-13 and 15-20 under 35 U.S.C. §102(b) as being anticipated by Bailey et al. (U.S.P. 5,835,084)

On pages 6-11 of the Office Action, the Examiner rejects claims 1-6, 8-13 and 15-20 under 35 U.S.C. §102(b) as being anticipated by Bailey et al. (U.S.P. 5,835,084).

The rejection is traversed. As set forth in MPEP §706.02 entitled Rejection on Prior Art, anticipation requires that the reference must teach every aspect of a claimed invention.

Applicant submits that Bailey does not support an anticipatory-type rejection by not describing features recited in at least the present application's independent claims 1, 8, and 15.

Independent claim 1, as amended herein, recites a device including:

- a) "a storing unit storing unread/already-read information corresponding to each of received electronic mails;" and
- b) "a controller indicating a change of the unread/already-read information corresponding to an unread electronic mail in a case where a body of the unread mail is displayed in response to a first command and not indicating the change of the unread/already-read information corresponding to the unread electronic mail in the case where a body of the unread mail is displayed in response to a second command; and
- c) "a managing module changing the unread/already-read information of the storing unit based on the indicating of the controller." Independent claims 8 and 15 have a similar recitation.

Applicant submits that Bailey does not teach, for example, a device including " . . . indicating a change of the unread/already-read information corresponding to an unread electronic mail in a case where a body of the unread mail is displayed in response to a first command and not indicating the change of the unread/already-read information corresponding to the unread electronic mail in the case where a body of the unread mail is displayed in response to a second command;" and " . . . changing the unread/already-read information of the storing unit based on the indicating of the controller," as recited by claim 1, for example.

By contrast, Bailey merely teaches:

An explicit action that causes the message to be marked as read occurs when the user explicitly opens the message (step 76). If the message is opened (i.e., the "yes" branch from step 76), the user is assumed to be reading the message and the mark_as_read flag is set to TRUE (step 78); otherwise, the flag remains FALSE. Other than this explicit action, there are other implicit heuristics which the computer monitors. Any one of these implicit heuristic conditions might be sufficient to conclude that the user has in fact read the highlighted message. One implicit heuristic is whether the user has scrolled the message while it is displayed in the preview pane (step 80). Scrolling evidences that the user has purposefully sought to view more of the message within the preview pane, thereby indicating that the user has read the message. If scrolling occurs, the mark_as_read flag is set to TRUE (step 78); otherwise, the flag remains FALSE. Another implicit heuristic is whether the user has had sufficient opportunity to read the message in the preview pane before highlighting another message or closing the message application. This implicit heuristic is accomplished by a two part test at steps 82 and 84. Essentially, the user is presumed to have read the highlighted message if the entire message fits within the preview pane (i.e., the "yes" branch from step

82) and the entire message remains visible for the selected time-out period (i.e., the "yes" branch from step 84). If both tests are met, the mark_as_read flag is set to TRUE (step 78); otherwise, the flag remains FALSE.

(see, for example, col. 5, lines 32-60).

That is, Bailey merely teaches automatically changed a status of a message upon an opening or scrolling of the message, a "sufficient opportunity" was given to read the message in a preview pane, or the message fits within a preview pane.

That is, Bailey does not teach any indicating of a change and not indicating of a change of the unread/already-read information corresponding to an unread electronic mail based respectively on a first command and a second command.

Summary

Since features recited by independent claims 1, 8, and 15 (and respective dependent claims 2-6, 9-13 and 16-20) are not taught by Bailey the rejection should be withdrawn and claims 1-6, 8-13 and 15-20 allowed.

Pages 11-12: Rejection of dependent claims 7, 14 and 21 under 35 U.S.C. §103(a) as being unpatentable over Bailey in view of Kudoh et al. (U.S.P. 5,948,058)

On pages 11-12 of the Office Action, the Examiner rejects claims 7, 14 and 21 under 35 U.S.C. §103(a) as being unpatentable over Bailey in view of Kudoh et al. (U.S.P. 5,948,058). The rejection is traversed.

I. Applicant submits that Kudoh does not teach an "indicating a change of the unread/already-read information corresponding to an unread electronic mail in a case where a body of the unread mail is displayed in response to a first command and not indicating the change of the unread/already-read information corresponding to the unread electronic mail in the case where a body of the unread mail is displayed in response to a second command;" and "... changing the unread/already-read information of the storing unit based on the indicating of the controller," as recited by independent claim 1, for example, and from which claim 7 depends.

Thus, Kudoh does not overcome the deficiency in the teachings of Bailey as discussed above, and for even this reason, the rejection should be withdrawn and dependent claims 7, 14, and 21 allowed.

II. Further, Applicant submits that features recited by claims 7, 14, and 21, themselves, are not taught by even an *arguendo* combination of Bailey and Kudoh and that the Examiner's interpretation of Kudoh is not correct. Dependent claim 7, for example, recites a device including "said list is deleted on a basis of a request for an end of reading the electronic mail.

Dependent claims 14 and 21 have similar recitations.

The Action concedes that Bailey does not teach "deleting message list on the basis of a request for an end (end command) for reading an electronic mail." (See, Action at page 11).

In the previous Amendment filed October 27, 2007, Applicant argued that the Examiner's interpretation of Kudoh is in error since Kudoh merely teaches:

When the user operates the I/O device 270 to enter the category C (omitted) (step 3319), the classification rule preparing unit 260 collects all positive and negative rules which have the category C (omitted) in the conclusion part from the classification rule storage unit 220 (step 3320), and checks whether or not the electronic mail Mk can be classified into the category C (omitted) by using the existing classification rule (step 3321). When it is judged that the electronic mail Mk can not be classified into the category C (omitted), the category C (omitted) is deleted from the classification of the electronic mail Mk stored in the electronic mail storage unit 240 (step 3325). When it is judged that the electronic mail Mk can be classified into the category C (omitted) by the existing rule, the header information on the electronic mail Mk is extracted, and its list is shown to the user (step 3322). When the user operates the I/O device 270 to select information as the classification conditions from the list and enter it (step 3323), the classification rule preparing unit 260 prepares a negative rule with the header information selected by the user as the condition part and the category C (omitted) as the conclusion part, and adds to the negative rule storage part 222 (step 3324). And, the category C (omitted) is deleted from the classification of the electronic mail Mk stored in the electronic mail storage unit 240.

(Emphasis added, see, for example, col. 28, line 55 to col. 29, line 13).

Applicant submits that Kudoh teaches either 1) the category, itself, is deleted from classifications or 2) messages having that category are not stored.

That is, Kudoh, in combination in Bailey, does not teach deleting a list on the basis of a request for an end of reading the electronic mail, as recited by claim 7, for example. Thus, the rejection should be withdrawn and dependent claims 7, 14, and 21 allowed.

III. Office Action Is Incomplete

But, in the current Office Action, the Examiner does NOT address the Applicant's argument presented in the previous Amendment traversing the rejection of claim 7, 14, and 21. The Examiner merely repeats his assertions from the previous Office Action in support of the rejection of claims 7, 14, and 21. (See, Action pages 11 -12)

Thus, Applicant submits that the current Office Action is incomplete. Thus, if the case is not found in a condition for allowance, Applicant requests that a new non-final Office Action be issued with a complete response.

Summary

Since features recited by dependent claims 7, 14 and 21 are not taught by the art relied on even in combination, the rejection should be withdrawn and claims 7, 14, and 21 allowed.

New Claim

New claim 23 recites features of the present invention in a different fashion. New claim 23 recites a method for controlling reading electronic mails by a computer, the method including "providing a user a choice of commands to issue to the computer for display of a body of unread electronic mail, the providing comprising: providing a first command for directing the computer to indicate a change of unread/already-read information corresponding to an unread electronic mail, and providing a second command for directing the computer to not indicate the change of the unread/already-read information corresponding to the unread electronic mail."

Support for new claim 23 is found, for example, in is found, for example, in Fig. 1 and page 8, line 21 - page 11, line 19 of the specification. These, and other, features of claim 23 are submitted to be allowable for the recitations therein.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date:

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By:

Paul W. Bobowiec

Paul W. Bobowiec

Registration No. 47,431

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501